



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

M

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,161	05/23/2000	Paul Lapstun	NPX016US	9177

24011 7590 04/22/2002

SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER

ABDULSELAM, ABBAS L

ART UNIT PAPER NUMBER

2674

DATE MAILED: 04/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

12 *18*

Office Action Summary

Application No.
09/575,161

Applicant(s)
PAUL LAPSTUN

Examiner
Abbas Abdulsalam

Group Art Unit
2674



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-108 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-108 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2674

DETAILED ACTION

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 1-108 provisionally rejected under the judicially created doctrine of double patenting over claim 1-56 of copending Application No.09/575,172. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

Regarding claim 1, it is met by a copending application claim 1. However, the copending application claim 1 does not specifically state "coded data indicative of at least one interactive element". The copending application claim 1 does teach "coded data indicative of a drawing field".

Art Unit: 2674

Therefore, it would have been obvious to one skilled in the art to recognize that “one interactive element” as claimed in the instant application and “drawing field” as claimed the copending application both correspond to each other and perform the same function.

Regarding claim 2, it met by a copending application claim 9. However, the copending application does not specifically state “a sensing device containing the identifying data and the identifying data being indicative of the identity of the user”. The copending application does teach “a sensing device indicating data indicative of the identity of the interface surface and generates movement data indicative of the sensing device’s movement relative to the interface surface”.

Therefore, it would have been obvious to one skilled in the art to recognize that the two statements in both applications correspond each other and serve the same purpose.

Regarding claim 53, it is met by a copending application 29. However, the copending application does not specifically state “operating a computer software partly in reliance on the user data”. The copending application does teach “operating a computer software partly in reliance on the movement of data”.

Therefore, it would have been obvious to one skilled in the art to recognize that “user data” as claimed in the instant application and “movement of data” as claimed in the copending application correspond to each other and are functionally equivalent.

Art Unit: 2674

Regarding claim 54, it met by a copending application claim 37. However, the copending application does not specifically state to "identify user data from the identifying data". However, the copending application does teach to "perform written gesture recognition in relation the movement of the data".

Therefore, it would have been obvious to one skilled in the art to recognize the two statements in both applications correspond each other and serve the same purpose.

Regarding claim 3, it met by the copending application claim.

Regarding claim 4, it is met by the copending application claims 5-6

Regarding claims 5, 15 and 68- 69, they are met by the copending application claim 2.

Regarding claims 6-7, 16 and 70, they are met by the copending application claim 3.

Regarding claims 8-9, they are met by the copending application 31.

Regarding claims 10-12, 17-19, 22-24, 31, 64-66, 71-73 and 76-78, they are met by the copending application claim 15.

Regarding claims 13-14, 67 and 83-85, they are met by the copending application claims 11-12.

Regarding claims 55, 20 and 74, they are met by the copending claim 30.

Regarding claims 21, 60-63 and 75, they are met the copending claim 31.

Regarding claims 25-28, 46-48, 52 and 79-82, they are met by the copending application claims 16-17.

Regarding claim 29, it is met by the copending application claims 44-45.

Art Unit: 2674

Regarding claim 30, it met by the copending application claim 46.

Regarding claims 32 and 86, they are met by the copending application claim 12.

Regarding claims 33 and 87, they are met by the copending application claim 33.

Regarding claims 34, 38, 41 and 88, they are met by the copending application claim 35

Regarding claims 35-36, 39-40, 42 and 89-94, they are met by the copending application claim 36.

Regarding claims 37 and 56, they are met by the copending application claims 33-34.

Regarding claims 43-45, they are met by the copending application claims 4-5.

Regarding claims 57-59, they are met by the copending application claim 40.

Regarding claims 95, and 100-102, they are met by the copending application claims 50-51.

Regarding claims 49, 96 and 103, they are met by the copending application claim 45.

Regarding claims 97-99, they are met by the copending application claim 32.

Regarding claims 50-51 and 104-105, they are met by the copending application claim 44.

Regarding claims 106, it is met by the copending application claim 46.

Regarding claims 107-108, they are met by the copending application claims 52-53.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Art Unit: 2674

3. Any inquiry concerning this communication or earlier communication from the examiner should be directed to **Abbas Abdulsalam** whose telephone number is **(703) 305-8591**. The examiner can normally be reached on Monday through Friday (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Richard Hjerpe**, can be reached at **(703) 305-4709**.

Any response to this action should be mailed to:

Commissioner of patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314

Hand delivered responses should be brought to crustal park II, Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology center 2600 customer Service office whose telephone number is (703) 306-0377.



RICHARD HJERPE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

Abbas Abdulsalam

Examiner

Art Unit 2674